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EXAMINER
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LAU, JONATHAN S

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1623

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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### **ADVISORY ACTION**

#### **Vacating of Office Action**

The previous Office Action, mailed 29 July 2008, is vacated because of the erroneous reference to a '177 PGPub. The current Office Action corrects the reference to Armour et al. (Arthritis and Rheumatism, of record).

Continuation of 3. NOTE: Applicant's Proposed Amendment 01 July 2008, would change the scope and breadth of the claim by requiring the specific limitation of degeneration of the cartilaginous matrix and excluding broader degenerative effects on cartilaginous matrix. This change in scope and breadth would require new search and further consideration of what the prior art discloses.

Continuation of 11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because: Applicant's remarks, filed 01 July 2008 have been fully considered and found not to be persuasive.

As recited in the Final Office Action, mailed 21 May 2008, Armour et al. discloses administration of flurbiprofen nitroxylbutylester by intraperitoneal injections to a mouse model of ovariectomy-induced bone loss, a subject with arthritis, anticipating the active steps and treatment population of the instantly claimed method. While Armour et al. is silent to the effect of HCT1026 on chondrocytes found in cartilage, it apparent from what is disclosed that the effect of HCT1026 on chondrocytes is an inherent property of the method disclosed by Armour et al. "[T]he claiming of a new use, new function or

unknown property which is inherently present in the prior art does not necessarily make the claim patentable", see MPEP 2112 I.

Note that "reducing the degenerative effects on cartilaginous matrix" is merely considered to be a new function or the unknown property or mechanism of action of a known treatment, administering an effective amount of said compound to a subject with arthritis. It has been settled that the claiming of a new use, new function or unknown property which is inherently present in the prior art method will not make the claim patentable as set forth in the 102(b) rejection relying upon Armour et al. (Arthritis and Rheumatism, provided by applicant as reference AN in IDS filed 08 Oct 2004, of record). That Applicant may have determined a mechanism by which the active ingredient gives the pharmacological effect does not alter the fact that the compound has been previously used to obtain the same pharmacological effects which would result from the claimed method. The patient, the condition afflicting said patient, and active step of administering an effective amount of said compound are the same. Thus, the method Armour et al. discloses is same as the method of the instant claims. An explanation of why that effect occurs does not make novel or even unobvious the treatment of the conditions encompassed by the claims.

Note that Applicant's Proposed Amendment, filed 01 July 2008, with respect to rejection of claims 1, 3, 4 and 7-9 under 35 USC 112, first paragraph for lack of enablement have been fully considered and if entered it would have overcome this

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rejection, as the claims would no longer recite the method of preventing degenerative effects on or degeneration of the cartilaginous matrix.

/Shaojia Anna Jiang, Ph.D./

Supervisory Patent Examiner, Art Unit 1623